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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/982,640
Filing Date: October 18, 2001
Appellant(s): SZMANDA, JEFFREY P.

Charles R. Szmanda
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/11/2006 appealing from the Office action mailed

11/09/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,098,065	SKILLEN	8-2000
6,421,652	LOEB	7-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1 – 42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Skillen

et al (U.S. 6,098,065).

♦ As per claim 1,

Skillen et al (U.S. 6,098,065) discloses a method of supplying advertisement information to a

user searching for information comprising:

-   " Receiving from the user, a series of search rules comprising facts about an

    advertisement" See col. 4 lines 5 – 6. The "search rules" as defined in the

    application, comprises keywords or phrases (paragraph 0035); Skillen provides a

    search argument that comprises plurality of terms. Therefore, the search rules

    corresponds to the "search arguments" that received from the user.

-   " Accessing a database comprising details of a plurality of advertisements" See

    col. 4, lines 31 – 40.

-   " Using a search engine to apply said search rules to said database" See Fig. 1,

    element 16, 18, col. 4, lines 31 – 45.

-   " Reporting to the user results comprising a subset of the content of said database"

    col. 4, lines 46 – 48.

♦ As per claim 2, 7, 12, 19, 26, 33,

-   " The user experienced said advertisement previously". Because the search request

    includes "desired information" (col. 1 lines 42 – 43), therefore, the user must experience

    with the advertisement or must see/know and show an interested in it in order to make the

    request.

♦ As per claim 3, 8, 13, 20, 27, 34,

- " The data network comprises the Internet" See Fig. 1, element 14, col. 3, lines 53 – 55.

♦ As per claim 4, 9, 14 - 16, 21 – 23, 28 – 30, 35 – 37, 41, 43,

  - " The algorithm of said search engine is selected from a group consisting of deductive

    reasoning, fuzzy logic and abductive reasoning" See col. 4, lines 14 – 25.

♦ As per claim 5, 10, 17, 24, 31, 38,

  - " Said advertisement information comprises contact information" referring to the

    specification "Search results can be in the form of <u>contact information</u> to enable the user

    to contact the advertiser or the advertiser's designee". According to col. 4 lines 64 – col. 5

    lines 6, a user can connect to the seller by clicking on the page displayed. This page

    displayed includes a site address. Therefore, the address corresponds to the "contact

    information".

♦ As per claim 6, 18, 32,

  - " Said user is a customer" See Fig. 1, the end user can be any type of user. In addition,

    the phrase "user is a customer" is considered as Nonfunctional descriptive material (See

    MPEP, section 2106 section VI), and cannot render nonobvious an invention that would

    have otherwise been obvious. If the prior art suggest that a user is an en user, merely

    choosing a user is a customer, would be presumed to be well within the level of ordinary

    skill in the art at the time the invention was made. The difference between the prior art

    and the claimed invention is simply a rearrangement of nonfunctional descriptive

    material.

♦ As per claim 11, 25,

With all limitation as claimed in claim 1 further claims 11, 25 include:

- "Querying the user to obtain one or more search rules" See col. 5 lines 7 – 17, col. 6 lines

    4 – 12. The user profile is maintained in the database 48, fig. 2. This information is

    accessed each time a new search is received. Therefore, the profile is corresponding to

    additional one or more search rules.

- " A first and second search engine to refine the search result" See Fig. 1, element 16, 18,

    col. 4, lines 49 – 55.

◆ As per claim 39, 42

With all limitations as in claim 1, further claim 39 and 42 include a "Search terms comprising

words having targeted connotative significance to a particular demographic segment". See col. 2,

lines 44 – 49.

◆ As per claim 40,

- " Said user is an advertiser" See col. 5, lines 3 – 6. " An advertiser" corresponds to the

    "seller".

2.   Claims 1 – 10, 39 – 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Loeb

et al (U.S. 6,421,652).

◆ As per claim 1,

Loeb et al (U.S. 6,421,652) discloses a method for supplying advertisement information to a user

searching for said information within a data network, comprising:

- " Receiving from the user, a series of search rules comprising facts about an

    advertisement" See Fig. 8, element 820, col. 9 lines 45 – 54. In particular,

- • "A series of search rules" corresponds to the responses to the plurality of
questions from the user.

- • These responses comprise information about a particular magazine or trade
publications that the user interested in, and is advertised by number of ways (col.
9 lines 12 – 19).

- – " Accessing a database comprising details of a plurality of advertisements" See col. 5,
lines 40 – 48.

- – " Using a search engine to apply said search rules to said database" See Fig. 2, element
260, col. 5, lines 40 – 48. The "Search engine" corresponds to the "search server" 260.

- – " Reporting to the user results comprising a subset of the content of said database" See
Fig. 8, element 830, col. 9, lines 54 – 58.

♦ As per claim 2, 7, 12, 19, 26, 33,

- – " The user experienced said advertisement previously". Because the advertising can be
advertised in different ways such as flyer, or website (col. 9, lines 18 – 19,24 – 26), the
user must experience with the promotion and show an interested in it in order to make the
request.

♦ As per claim 3, 8, 13, 20, 27, 34,

- – " The data network comprises the Internet" See col. 4, lines 14 – 16.

♦ As per claim 4, 9, 14 - 16, 21 – 23, 28 – 30, 35 – 37, 41, 44,

- – " The algorithm of said search engine is selected from a group consisting of deductive
reasoning, fuzzy logic and abductive reasoning" See Fig. 10, col. 12, lines 2 – 6.

♦ As per claim 5, 10, 17, 24, 31, 38,

- " Said advertisement information comprises contact information" See Fig. 5 – 6, col. 8,

  lines 45 – 51.

♦ As per claim 6, 18, 32,

- " Said user is a customer" See Fig. 1, where "customer" corresponds to the "consumer".

  In addition, the phrase "user is a customer" is considered as Nonfunctional descriptive

  material (See MPEP, section 2106 section VI), and cannot render nonobvious an

  invention that would have otherwise been obvious. If the prior art suggest that a user is a

  consumer, merely choosing a user is a customer, would be presumed to be well within the

  level of ordinary skill in the art at the time the invention was made. The difference

  between the prior art and the claimed invention is simply a rearrangement of

  nonfunctional descriptive material.

♦ As per claim 39, 42

With all limitations as in claim 1, further claim 39 in includes a "Search terms comprising words

having targeted connotative significance to a particular demographic segment". Referring to Fig.

11C, the user must enter their choices by selecting the appropriate answer or type in the answer

(col. 13, lines 23 – 28). These responses correspond to the "search terms" that comprising

plurality of words.

♦ As per claim 40,

- " Said user is an advertiser" See col. 1, lines 42 – 53.

3.   Claims 11 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb et al

(U.S. 6,421,652).

♦ As per claim 11, 25,

With all limitation as claimed in claim 1 further claims 11, 25 include:

- "Querying the user to obtain one or more search rules" corresponds to the questions that

  to be asked by the controller.

Applicant uses a first and second search engine to refine the search result. Referring to Fig. 10,

element 1025 – 1040, Loeb discloses a logic for eliminate the result by providing more questions

to be asked to the consumer. As the result, only a certain numbers of magazines are available for

certain consumer (See Fig. 11B). clearly, Loeb discloses a method to refine the search result

using a search engine. However, Loeb does not clearly disclose two separate search engines.

Loeb, refers to another search engine to do the job if the current fails (see Fig. 2, element 262,

col. 5, lines 16 – 18, 47 – 48). It is clear that the claimed provision is inherent. Nonetheless, to

expedite prosecution, even if the limitation of the above were not inherent, it would have been

obvious to one with ordinary skill in the art at the time the invention was made to use multiple

search engines to search for information, because it provides more availability of the system to

the user in the searching process.

♦ As per claim 12 – 24, 26 – 38 are rejected based on the rejections above.

(10) Response to Argument

In Appellant's Brief, filed May 11, 2006, Appellant argues (12) specific points:

1) Skillen and Loeb do not disclose: "receiving, from the user, a series of search rules

comprising facts about an advertisement" (page 11 and 28 of the Appeal Brief).

2) Skillen and Loeb do not disclose: "accessing a database comprising details of a plurality of

advertisements" (page 13 and 30 of the Appeal Brief).

3) Skillen and Loeb do not disclose: " using a search engine to apply said search rules to said database" (page 14 and 31 of the Appeal Brief).

4) Skillen and Loeb do not disclose: "reporting, to the user, results comprising a subset of the contents of said database" (page 14 and 31 of the Appeal Brief).

5) Skillen does not disclose: "querying the user to obtain one or more search rules comprising facts about an advertisement" (page 15 of the Appeal Brief).

6) Skillen does not disclose: "using a first search engine to apply said search rules to said database to obtain results comprising a first subset of the contents of said database" (page 17 of the Appeal Brief).

7) Skillen does not disclose: "receiving, from the user, one or more keywords; using said keywords and a second search engine to query said first subset" (page 17 of the Appeal Brief).

8) Skillen does not disclose: "reporting, to the user, results comprising a second subset of the contents of said database, wherein said second subset is smaller than said first subset" (page 18 of the Appeal Brief).

9) Skillen does not disclose: "receiving, from the user, a first list of keywords; generating a second list of keywords, said second list comprising keywords or phrases synonymously related to one or more keywords or phrase in said first list" (page 19 of the Appeal Brief).

10) Skillen and Loeb do not disclose: "receiving a set of search terms comprising words having targeted connotative significance to a particular demographic segment" (page 20 and 33 of the Appeal Brief).

11) Skillen and Loeb do not disclose: "reporting results of the search comprising a subset of

the contents of said database, said results being indexed uniquely" (page 23 and 36 of the

Appeal Brief).

12) Skillen and Loeb do not disclose: "repeating steps (a) – (d) a number of times with at

least one different search term in said list, said number being sufficient to cover the desired

demographic space" (page 23 and 36 of the Appeal Brief).

The Federal Circuit has embraced a theory of prima facie obviousness for use in ex parte

prosecution in the PTO. The prima facie case is a procedural tool that, as used in patent

examination, means not only that the evidence of the prior art would reasonably allow the

conclusion that the examiner seeks, but also that the prior art compels such a conclusion if the

Appellant produces no evidence or argument to rebut it.   See *In re Spada*, 911 F.2d 705, 15

USPQ2d 1655 (Fed. Cir. 1990).   In the instant case, the prior art compels the conclusion that the

claimed invention is unpatentable under 35 U.S.C. §103(a) as set forth in the Final Office

Action, mailed November 9, 2005, and reiterated above for convenience.

Each of Appellant's (12) arguments above fails to rebut the *prima facie* showing of obviousness

for the reasons discussed below.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 1:

Skillen and Loeb do not disclose: "receiving, from the user, a series of search rules comprising

facts about an advertisement" (page 11 and 28 of the Appeal Brief).

First, Appellant's first argument is unpersuasive because Skillen clearly discloses a

search engine that allows the user to input the search information (search rules) that comprising

the desired information (facts about an advertisement) (See col. 1, lines 50 – 57, col. 4, lines 29 -

30 of Skillen). The system of Skillen is an advertising system (col. 2, lines 44 – 45 of Skillen).

Therefore, the information in the system that the user searching is the advertisement information.

Second, Appellant's first argument is unpersuasive because Loeb clearly discloses that at

col. 9, lines 10 – 65, the system is an advertising system, so that the information can be

advertised to the user in numerous ways. The information that the user enters into the question

corresponds to the "search rules comprising facts about an advertisement" since the user using

the advertisement system to search or subscribe to a particular publication.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 2:

Skillen and Loeb do not disclose: "accessing a database comprising details of a plurality of

advertisements" (page 13 and 30 of the Appeal Brief).

Skillen discloses that the search engine in the advertising system (col. 2, lines 44 – 45 of Skillen)

will search for the match in response to the user query (col. 4, lines 31 – 40 of Skillen).

Therefore, the database in Skillen must comprising details of a plurality of advertisements.

In the same manner, Loeb also discloses that the system also allows to compare the input by the

user with the stored value (col. 9, lines 54 – 65, Loeb). Therefore, the database in Loeb also

comprises details of a plurality of advertisements.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 3:

Skillen and Loeb do not disclose: " using a search engine to apply said search rules to said

database" (page 14 and 31 of the Appeal Brief).

Appellant's argument is unpersuasive because Skillen clearly discloses a search engine

that allows the user to input the search information (search rules) that comprising the desired

information (facts about an advertisement) (See Fig.1, element 16, 18, col. 1, lines 50 – 57, col. 4, lines 29 - 30 of Skillen).

Loeb also has to use a search engine to retrieve and compare the input form the user and the information in the database (col. 9, lines 54 – 65 of Loeb).

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 4:

Skillen and Loeb do not disclose: "reporting, to the user, results comprising a subset of the contents of said database" (page 14 and 31 of the Appeal Brief).

Appellant's argument is unpersuasive because Skillen clearly discloses a system that returns search result to the user. The result corresponds to a "subset of the contents of said database" (col. 4, lines 41 – 45 of Skillen).

Loeb also teaches that the user will receive the appropriate trade publications based on the input (col. 9, lines 54 – 65 of Loeb). Therefore, the trade publication corresponds to the result that is a "subset of the contents of said database".

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 5:

Skillen does not disclose: "querying the user to obtain one or more search rules comprising facts about an advertisement" (page 15 of the Appeal Brief).

By obtaining the user profile and the search rule, Skillen clearly teaches that the system queries the user to obtain one or more search rules comprising facts about an advertisement (col. 6, lines 1 – 12 of Skillen).

Loeb teaches that the advertising can be provided in a number of ways, such as sending a universal questionnaire (col. 9, lines 14 – 44). The questionnaire corresponds to the search rule

that is sent to the user in order to querying the user to obtain one or more search rules comprising

facts about an advertisement.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 6:

Skillen does not disclose: "using a first search engine to apply said search rules to said

database to obtain results comprising a first subset of the contents of said database" (page 17 of

the Appeal Brief).

As shown in Fig. 1, Skillen discloses a two different search engine, database search

engine and associative search engine to retrieve the result from the database. Therefore, Skillen

clearly disclose "using a first search engine to apply said search rules to said database to obtain

results comprising a first subset of the contents of said database".

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 7:

Skillen does not disclose: "receiving, from the user, one or more keywords; using said keywords

and a second search engine to query said first subset" (page 17 of the Appeal Brief).

Appellant's argument is unpersuasive because Skillen clearly discloses the end user sends

the search argument to the database search engine (col. 4, lines 29 – 30 of Skillen). Therefore,

the search argument corresponds to the keywords in the claim invention. Using this search

argument (keywords), the second search engine will search again the result as the user want to

refine the search (col. 4, lines 46 – 55 of Skillen).

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 8:

Skillen does not disclose: "reporting, to the user, results comprising a second subset of

the contents of said database, wherein said second subset is smaller than said first subset" (page

18 of the Appeal Brief).

As in argument 7, the user can refine the search result. Therefore, the second result

coming back to the user corresponds to the second subset of the contents of said database, and

second subset is smaller than said first subset.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 9:

Skillen does not disclose: "receiving, from the user, a first list of keywords; generating a

second list of keywords, said second list comprising keywords or phrases synonymously related

to one or more keywords or phrase in said first list" (page 19 of the Appeal Brief).

This operation corresponds to the method that allows the user to enter search argument

and then refine the search (see response above). The refine search comprises the search argument

or additional search keyword that related to the first result. Therefore, the refine search argument

corresponds to the second list of keywords, said second list comprising keywords or phrases

synonymously related to one or more keywords or phrase in said first list.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 10:

Skillen and Loeb do not disclose: "receiving a set of search terms comprising words having

targeted connotative significance to a particular demographic segment" (page 20 and 33 of the

Appeal Brief).

The Examiner interpreted the phrase "search terms comprising words having targeted

connotative significance to a particular demographic segment" corresponds to the search

argument in Skillen and the universal questionnaire in Loeb.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 11:

Skillen and Loeb do not disclose: "reporting results of the search comprising a subset of the contents of said database, said results being indexed uniquely" (page 23 and 36 of the Appeal Brief).

Skillen teaches that the result is presented to the use in a predictive order and fashion (col. 2, lines 23 – 30 of Skillen). Therefore, the results are being indexed uniquely.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 12:

Skillen and Loeb do not disclose: "repeating steps (a) – (d) a number of times with at least one different search term in said list, said number being sufficient to cover the desired demographic space" (page 23 and 36 of the Appeal Brief).

Skillen discloses this technique by allowing the user to refine the search in order to retrieve the desired information.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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